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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,241

01/19/2006

Walter Kuhn

50160

9150

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7590

07/22/2010

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EXAMINER

GRESO, AARON J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,241	Applicant(s) KUHN ET AL.	
	Examiner AARON GRESO	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7, and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 June 2010 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed 09 June 2010 (per PCT/EP2004/051292 and indicating DE 10332908.0 filed 19 July 2003). It is noted, however, that applicant has not noted the priority documents in the instant Specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 and its subsequent dependent Claims 2, 4, 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The lower amount of trans material is not indicated; the upper amount of cis material is not indicated.

Appropriate action is required.

To further prosecution: The lower amount of trans material is therefore taken as any amount as long as it is 20% or less than 20%. In addition, while the minimum amount of cis material is indicated to be at least 80%, the upper amount is not indicated. The upper amount is therefor taken to include any amount greater than 80% or 80%.

Further as to Claims 1 and its dependent Claims 2, 4, 5:

The specific percentage basis is not provided in the Claims {e.g., volume, mole, weight}.

To further prosecution, the percentage is taken to correspond to any percentage basis.

Claims 7, its dependent Claim 9, and Claims 11-18 recite the limitation "total composition includes at least 80%". There is insufficient antecedent basis for this limitation in the Claim; only proportional amounts of cis materials is provided. To further prosecution, the 80% amount is taken as representing any amount in any proportion or relative proportion with other materials or compositions.

Claim Rejections - 35 USC § 102(b)

Claims 7, 9-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Eliel et al. (Journal of Organic Chemistry 1970, Vol 35 (8) pp 2716-2722).

Eliel et al. discloses making cis 3,3,5-trimethylcyclohexyl acetate (p 2722 1st full paragraph) in an amount of 89%. The process would be expected to add cis material to a composition as it reacts from cis 3,3,5-trimethylcyclohexanol precursor.

Further as to Claims 9-18:

The properties or scent of the material to the final composition, being added during synthesis, {taken as the reference is intent to make the material, with its properties}, would be expected to be inherent.

Claim Rejections - 35 USC § 102(b)/103(a)

Claims 1, 2, 4, 5, are rejected under 35 U.S.C. 102(b) as being anticipated by Behura et al. (Current Science Vol 83 no 11 pp. 1312-1313, 2002).

As to Claim 1:

The reference indicates that the essential oil of Curcuma longa, acquired from the Rhizome of C. longa, is employed for curing pimples and for the whitening of skin and is also indicated to exhibit a camphor odor (col 1 paragraphs 1 and 2 page 1312).

The properties and composition of the oil are taken as inherent.

As compositions of the oil material is indicated to comprise cis 3,3,5-trimethylcyclohexyl acetate {see informational reference: Chowdhury et al. Bangladesh J. Sci. Ind. Res. 43 (2) pp 259-266 2008, Table II, page 264 and page 259 col 1, 1st

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paragraph} the material is taken to have been used more than one year prior to the Applicants' filing.

Further as to Claim 2:

As the reference does not disclose the amount of a Claimed trans material, a trans material is not taken to be present in an amount that is measured; that amount being less than 0.005 percent {an amount that would be expected to be rounded up to 0.01 percent}; only 2 significant digits past the zero being reported by Behura et al.

As to Claim 4: As the material is indicated to comprise 1,8-cineole as a 28 percent component (Behura et al. Table 1 page 1312), and as 1,8-cineole is indicated to make odors fresher {see informational reference: 1,8-cineole, The Good Scents Company page 3}, it would be expected that the composition disclosed would make materials, it is added to, comprise a fresher enabling substance than without the material for, example, a composition for treating whiteness of skin, when compared to a skin treatment composition that does not comprise the mixture and otherwise not comprising the ester containing oil composition.

As to Claim 5:

The oil composition comprises at least one other fragrance substance (Table 1 page 1312).

In the alternative:

As Behura et al. does not indicate that the material does not comprise a trans component, the material is taken to comprise a trans component of 3,3,5-trimethyl

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cyclohexyl acetate less than the corresponding cis chemical. As it is also taken that nature would be expected to allow for variations in chemical compositions {see Behura et al. col 2, 2nd full paragraph page 1312}, the essential oil compositions are taken to comprise appropriate trans materials in amounts as low as those allowed by the Claim 1 and its subsequent dependent Claims 2, 4, 5, 7 and 9-18.

Response to Arguments

Applicant's arguments with respect to Claims 1, 2, 4, 5, 7 and 9-18, have been considered but are moot in view of the new ground(s) of rejection due to Applicants filing amendment to the Continued Examination of this Application.

Examiner Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571 272 1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1796

/Aaron J. Greso/